

Appln. No. 10/616,753
Docket No. 130373/GEN-0346

REMARKS / ARGUMENTS

Status of Claims

Claims 1-39 are pending in the application and stand rejected. Applicant has amended Claims 1-4, 22 and 25, leaving Claims 1-39 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Claim Objections

Claims 3, 4 and 25 are objected to for various informalities.

Applicant has amended Claims 3, 4 and 25, as well as Claims 1, 2 and 22, to correct for the informalities.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this objection, which Applicant considers to be overcome by the amendments presented herein.

Rejections Under 35 U.S.C. §103(a)

Group-I: Claims 1, 2, 6, 8, 9, 10, 16, 22, 23, 27, 29, 30, 31 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi (U.S. Patent No. 5,051,706, hereinafter Zushi) in view of Kane (U.S. Patent No. 4,614,925, hereinafter Kane). Paper 04242006, page 3.

Group-II: Claims 3, 7, 24 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Kane and Roberts, Jr. et al. (U.S. Patent No. 6,661,634, hereinafter Roberts). Paper 04242006, page 5.

Group-III: Claims 4, 5, 17, 25, 26 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Kane and Havot et al. (U.S. Patent No. 5,121,078, hereinafter Havot). Paper 04242006, page 7.

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Group-IV: Claims 11 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Kane and Brandeau (U.S. Patent No. 4,750,266, hereinafter Brandeau). Paper 04242006, page 9.

Group-V: Claims 12 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Kane and Shimada et al. (U.S. Patent No. 6,020,867, hereinafter Shimada). Paper 04242006, page 9.

Group-VI: Claims 13, 14, 18, 19, 34, 35 and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Kane and Stahl (U.S. Patent No. 5,388,021, hereinafter Stahl). Paper 04242006, page 10.

Group-VII: Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Roberts. Paper 04242006, page 12.

Group-VIII: Claims 15 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Kane and Bender (U.S. Patent No. 6,926,288, hereinafter Bender). Paper 04242006, page 12.

Group-IX: Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Zushi in view of Kane and Knigge et al. (U.S. Patent No. 6,639,779, hereinafter Knigge). Paper 04242006, page 13.

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Additionally, Applicant respectfully submits that obviousness cannot be supported by a proposed modification that would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01.

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Regarding Group-I

Claims 1 and 22 have been amended to recite, inter alia:

“...a first filter with a first end and a second end, *said first end is operably connected in series with a first power input terminal of the apparatus, said second end is operably connected to a first output terminal of the apparatus, thereby disposing said first filter in series with and between said first power input terminal and said first output terminal*; and

an impedance comprising a first conductor on a first layer of a circuit card forming a distributed inductance in series with said first filter, said impedance also including a second conductor on a second layer of said circuit card operably connected to a ground, said first conductor and said second conductor forming a distributed capacitance, and wherein said impedance is configured to facilitate matching of an input impedance of the filtering apparatus with that of a voltage source and said distributed inductance and said distributed capacitance cooperate to provide filtering of electromagnetic interference.”

Here, Applicant is claiming a first filter having first and second ends that are operably connected in series with input and output terminals of the apparatus *such that the first filter is disposed in series with and between the input and output terminals, and an impedance forming a distributed inductance and a distributed capacitance* where the distributed inductance is in series with the first filter, thereby necessarily resulting in *the distributed inductance of the impedance being in series with the input and output terminals.*

Dependent claims inherit all of the limitations of the respective parent claim.

In alleging obviousness of Claims 1 and 22, the Examiner alleges that Zushi teaches all of the claimed limitations except for “a first conductor on a first layer of a circuit card forming a distributed inductance in series with said filter, said impedance also including a second conductor on a second layer of said circuit card operably connected to a ground”, and relies on Kane to cure this deficiency. Paper 04242006, pages 3-4.

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Applicant respectfully disagrees that the combination of references teaches or suggests each and every element of the claimed invention arranged so as to perform as the claimed invention performs.

Firstly, the Examiner alleges that Zushi teaches the claimed first filter (Zushi element 24') operably connected in series with input and output terminals (Zushi element 2 and left side of 4, and element 19 and right side of 5). Paper 04242006, page 3.

At column 8, lines 13-17, Applicant finds Zushi to teach one end of filter element 24' to be connected to the input side of amplifying element 41.

At column 7, lines 30-37, Applicant finds Zushi to teach a second end of filter element 24' to be connected to a gate bias terminal 43 subject to bias voltage VB, and to ground point VSS via capacitor 23.

Accordingly, and contrary to the Examiner's allegation, Applicant does not find Zushi filter element 24' to be operably connected *in series with and between the first power input terminal and the first output terminal of the filtering apparatus*, as claimed in the instant invention.

In view of the claimed first filter of the instant invention being in series with and between the first power input terminal and the first output terminal, and the Zushi filter element 24' being disposed between an amplifier 41 and a gate bias terminal 43, Applicant submits that *the Zushi filter 24' will not perform as the claimed invention performs* as it is disposed between substantially different components as the claimed first filter.

Secondly, the Examiner alleges that Kane teaches the claimed distributed inductance and capacitance on a circuit card, and that one skilled in the art would be motivated to modify the Zushi device with the Kane device to arrive at the claimed invention.

In respectful disagreement with the Examiner, Applicant finds no teaching, suggestion or motivation from the references themselves to apply Kane to modify Zushi to arrive at the claimed invention.

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At column 2, lines 23-32, Applicant finds Kane to teach a resonator filter having inductor and capacitor components.

At column 11, lines 35-39, Applicant finds Kane to teach a resonator filter having distributed inductance and capacitance.

Nowhere does Applicant find Kane to teach how or why the Kane resonator filter would be suitable for modifying Zushi to arrive specifically at the claimed invention, and the Examiner has not stated with specificity where Kane, or Zushi, do teach such a suitable modification.

Furthermore, if Zushi were to be modified by Kane as alleged by the Examiner, Applicant submits that the modification still would not perform as the claimed invention performs, as Zushi modified with the Kane resonator filter still does not teach or suggest *"a distributed inductance in series with said first filter, said impedance also including a second conductor on a second layer of said circuit card operably connected to a ground, said first conductor and said second conductor forming a distributed capacitance"*, which is specifically claimed for in the instant invention.

Additionally, the Examiner alleges that Zushi can be modified by Kane without stating with specificity what aspect of Zushi is being modified.

If the Examiner is alleging that Zushi can be modified by Kane by adding the Kane element of distributed inductance and capacitance, then Applicant submits that the Zushi device would no longer be suitable for its intended purpose as Zushi teaches a high power amplifier circuit absent distributed inductance and capacitance.

If the Examiner is alleging that Zushi can be modified by Kane by modifying and element of Zushi to introduce the Kane element of distributed inductance and capacitance, then Applicant again submits that the Zushi device would no longer be suitable for its intended purpose as Zushi teaches a high power amplifier circuit absent distributed inductance and capacitance.

Accordingly, Applicant submits that a prima facie case of obviousness cannot be established where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.

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For at least the foregoing reasons, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, fail to teach a modification to a primary reference that would render the primary reference still suitable for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

Regarding Groups II-IX

In view of the references of Groups II-IX not being applied against independent Claims 1 and 22, Applicant respectfully submits that the respective dependent claims are patentable over the cited references at least for the reason that they depend from allowable independent claims.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §103(a), have been traversed, and respectfully requests that the Examiner reconsider and withdraw these rejections.

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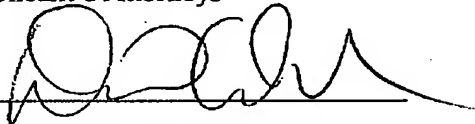
The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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